



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/501,408	02/10/2000	Frederic Serre	A32979-070337.0181	3806

7590

10/15/2002

Baker & Botts
30 Rockefeller Plaza 44th Floor
New York, NY 10112-4498

EXAMINER

SHOSHO, CALLIE E

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 10/15/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

16

Office Action Summary

Application No.

09/501,408

Applicant(s)

SERRE, FREDERIC

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicant's amendment filed 8/5/02.

It is noted that applicant requests that the examiner defer the rejections relating to JP 09302146 until a certified English translation of the reference has been provided to the applicant. While an English translation of JP 09302146 is included in this office action, given that the examiner is relying on the same portions of the reference as in the previous office action mailed 3/4/02, Paper No. 13, it is the examiner's position that deferral of the rejections with respect to JP 09302146 is not necessary given that the English translation does not provide any additional information necessary to reject the present claims that was not previously disclosed and discussed by the examiner in the previous office action.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 14-16 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 09302146 taken in view of the evidence in Miyazaki et al. (U.S. 6,109,320) and Agostini et al. (U.S. 6,160,047).

The rejection is adequately set forth in paragraph 4 of the office action mailed 3/4/02, Paper No. 13, and is incorporated here by reference.

NOTE: An English translation of JP 09302146 is included with this office action.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 09302146 in view of Takeichi et al. (U.S. 6,008,295).

The rejection is adequately set forth in paragraph 7 of the office action mailed 3/4/02, Paper No. 13, and is incorporated here by reference.

6. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 09302146 in view of Fukahori et al. (U.S. 5,844,050).

The rejection is adequately set forth in paragraph 8 of the office action mailed 3/4/02, Paper No. 13, and is incorporated here by reference.

Response to Arguments

7. Applicant's arguments regarding EP 738614 and Suzuki et al. (U.S. 5,902,856) have been fully considered but they are moot in view of the discontinuation of these references against the present claims.

8. Applicant's arguments filed 8/5/02 have been fully considered but, with the exception of arguments relating to EP 738614 and Suzuki et al., they are not persuasive.

Specifically, applicant argues that:

(a) JP 09302146 discloses amount of silica and/or carbon black outside the ranges presently claimed.

(b) It is not proper for the examiner to rely on other references, i.e. Agostini et al. and Miyazaki et al., beside JP 09302146 to reject claims under 35 USC 102.

(c) There is no motivation to combine JP 09302146 with either Takeichi et al. or Fukahori et al. given that both Takeichi et al. and Fukahori et al. are drawn to composition for external tire parts not internal parts as presently claimed.

With respect to argument (a), applicant point to example 3 of Table 2 of JP 09302146 and notes that this example teaches the use of 100 phr of silica that falls outside the amount of 15-40 phr presently claimed. Applicant also points to examples 2 and 3 of Table 1 and examples 2 and 4-6 of Table 2 of JP 09302146 and notes that these examples teach amounts of total silica plus carbon black of 80-150 phr which falls outside the scope of the amount of 15-50 phr presently claimed.

However, these examples are just a few preferred embodiments of JP 09302146. It is noted that “applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others.” *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). Further, “nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims.” *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). A fair reading of the reference as a whole discloses that the composition comprises 20-

Art Unit: 1714

150 parts silica and 0-50 parts carbon black (see, for instance, the abstract previously cited by the examiner in the office action mailed 3/4/02) and thus 20-200 parts silica plus carbon black which clearly overlaps the presently claimed amounts of 15-40 phr silica and 15-50 phr silica plus carbon presently claimed.

With respect to argument (b), it is noted that Agostini et al. and Miyazaki et al. are not themselves used to reject present claims 14-16 and 18-20, rather there are used as evidence to define terms already disclosed by JP 09302146 which is used to reject the claims.

As set forth in MPEP 2131.01 II, "extrinsic evidence may be used to explain but not expand the meaning of terms and phrases used in the reference relied upon as anticipatory of the claimed subject matter". Further, MPEP 2131.01 III discloses that "to serve as an anticipation when reference is silent with asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence".

Thus, it is the examiner's position that the 35 USC 102 rejection as set forth in paragraph 3 above is proper.

With respect to argument (c), it is noted that with respect to Fukahori et al., col.25, lines 32-34 of the reference discloses rubber composition for tire wherein the composition is suitable not only for external parts of the tire, but also suitable for bead portions of the tire. Thus, the disclosure of Fukahori et al. is clearly applicable to both external and internal portions of the tire.

With respect to Takeichi et al., it is noted that according to MPEP 2141.01 (a), a reference may be relied on as a basis for rejection of an applicants' invention if it is "reasonably

pertinent to the particular problem with which the inventor is concerned.” A reasonably pertinent reference is further described as one which “even though it maybe in a different field of endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” Takeichi et al. is, therefore, a reasonably pertinent reference, because it teaches that the use of silicon or tin halide modified diene elastomer in tires in order to produce a tire with superior fracture properties and low hysteresis loss, which is a function especially pertinent to the invention at hand.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

Art Unit: 1714


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie Shosho

10/11/02



VASU JAGANNATHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700